

REMARKS

This is in full and timely response to the Office Action (Mail Date 34) dated May 11, 2004. Reexamination and reconsideration are respectfully requested.

Reference may be made to the last Brief on Appeal of February 4, 2004, resulting in a reopening of prosecution to state new grounds of rejections *RELYING ON THE SAME REFERENCES AS RELIED UPON IN THE APPEAL*, merely restated as new grounds of rejection. This is thus a Reply under 37 C.F.R. §1.111 in that the Action of May 11, 2004 a non-final action.

At the outset, it is noted that the Examiner has relied on the U.S. patent to Philyaw, No. 6,377,986, issued April 23, 2002 ("Philyaw '986") in support of the rejection of: (1) claims 26, 28, 30 to 32, and 44, as stated in the anticipation rejection of section 2 spanning pages 2 to 4 of the Action; (2) claims 1 to 18, 22 and 23 as stated in the obviousness rejection of section 5 mentioned at page 7 of the Action and discussed at pages 8 to 15; (3) claims 27, 29, 33 to 43, 45, and 46 as stated in the obviousness rejection of section 6 on page 7 and discussed with the rejection (2) as discussed fully at pages 8 to 15 of the Action. At the bottom of each of these rejections is reliance on portions of Philyaw '986, such as at column 19, lines 11 to 61 that a wand 1600 identifies a user and a method of targeting coupons based primarily on the use of a device ID. No other specific portion of Philyaw '986 was relied upon; indeed, prior

reliance on other portions of Philyaw '986 as discussed in the Appeal Brief of February 4, 2004 was withdrawn in favor of reliance on column 19, lines 11 to 61.

U.S. patent application Ser. No. 09/494,925 maturing into Philyaw '986 was filed on February 1, 2000, which is after the November 30, 1999 filing date of the above-identified application to Steven R. Boal.

However, the application maturing into Philyaw '986 is a Continuation of U.S. patent application Serial No. 09/378,221, filed on August 19, 1999, which is a Continuation-in-Part of U.S. patent application Serial No. 09/151,471, filed on September 11, 1998, and U.S. patent application Serial No. 09/151,530, filed on September 11, 1998 (which issued on Aug. 1, 2000 as U.S. Patent No. 6,098,106).

The portion of Philyaw '986 relied upon appears from a review of the file histories of its parent applications to have been added in an application filed as a "continuation-in-part" application on August 19, 1999. Thus, the portion of Philyaw '986 relied upon, even if all of the arguments based on Philyaw '986 were treated as established, is only entitled to a date of August 19, 1999.

According to the Declaration of Steven R. Boal under 37 C.F.R. §1.131 ("Rule 131 Declaration"), the invention was complete in late 1998 or early 1999. In addition, notes of a conversation with the Applicant and the undersigned attorney of

August 11, 1999 further establish that the invention was complete prior to the effective filing date of August 19, 1999 to which the disclosure of Philyaw '986 that is relied on by the examiner is entitled. Therefore, all rejections based on Philyaw '986 as discussed with reference to the wand 1600 or the disclosure at column 19 should be withdrawn as a matter of due course.

Still further, Exhibit E to the Boal Declaration dated January 4, 1999 notes that the system was complete and that the system used a device ID. Thus, the Applicant antedates both Schreiber and Mankoff as to the device ID.

The Applicant, however, reserves its right to argue that the portions of Philyaw '986 relied upon are selected by hindsight and that those portions of Philyaw '986 do not show use of a device ID as claimed.

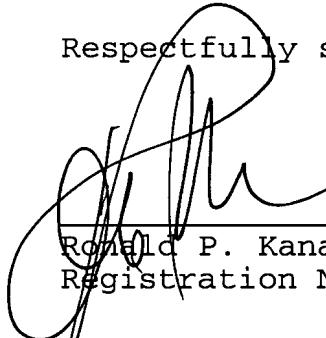
Claims 24 and 25 were rejected as obvious over Schreiber U.S. patent No. 6,298,446 in view of Mankoff U.S. patent No. 6,385,591. To the extent that Schreiber is relied on for a disclosure having an effective date of May 11, 1999, the Applicant's Rule 131 declaration shows a conception of the use of the URL features at least as early as June 6, 1998 (the "Walsh memorandum as Exhibit D of the Declaration) and a disclosure of the invention on January 4, 1999 referring, among other things to the device ID, sufficient to antedate the Schreiber and Mankoff references.

As above, the Applicant preserves its rights to argue against the findings relative to Schreiber and Mankoff individually or on the reasons for making the combinations taking into account the documents showing portions of the invention of June 6, 1998, January 4, 1999 and August 11, 1999.

All or portions of the three references relied upon, having been removed by the Applicant's Rule 131 Declaration, this application is in condition for allowance.

If the examiner proposes to dispose of this application by other than a Notice of Allowance, the undersigned requests a personal interview to discuss the supporting documents and their showing relative to these or other references on an individual basis.

Respectfully submitted,

  
Ronald P. Kananen  
Registration No. 24,104

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**RADER, FISHMAN & GRAUER PLLC**  
Lion Building  
1233 20<sup>th</sup> Street, N.W.  
Washington, D.C. 20036  
Tel: (202) 955-3750  
Fax: (202) 955-3751  
Customer No. 23353